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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,150	01/04/2002	Jeffrey Allen Sturgill	UVD 0299 PA	7448

23368 7590 11/08/2006

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EXAMINER

KASTLER, SCOTT R

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/038,150	Applicant(s) STURGILL ET AL.	
	Examiner Scott Kastler	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-53 and 123-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-53 and 123 is/are allowed.
- 6) ☒ Claim(s) 124-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/06, 7/12/06</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS Filed 4/14/06</u> . |

Art Unit: 1742

Reopening of Prosecution After Appeal

In view of the Information Disclosure Statements filed on 8/8/2006 and 7/12/2006 filed after the notice of Appeal, filed on 7/3/2006, PROSECUTION IS HEREBY REOPENED. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 124-126 are rejected under 35 U.S.C. 102(b) as being anticipated by Schreiber'606 (U.S. Patent No. 5,411,606). Schreiber'606 teaches a corrosion coating bath consisting essentially of a solvent, and a cobalt-III hexacarboxylate complex. The cobalt-III hexacarboxylate complex solution is formed by dissolving and reacting a metal carboxylate salt and a soluble cobalt-II salt to form the cobalt-III hexacarboxylate complex containing solution (col. 2, line 67 to col. 3 line 12). The metal carboxylate salt is used to prevent valence shift (col. 6, line 60 to col. 7 line 10) and therefore is considered to be encompassed by the valence stabilizer recited in the above claims. The resulting cobalt-III hexacarboxylate complex is considered to be encompassed by the instant claim language "cobalt/valence stabilizer complex" recited in the instant claims. The use of the composition "for a barrier film" is at best a suggested use of the claimed composition and as such cannot be relied upon to fairly further limit the instant composition claims (see MPEP 2115). With respect to the solubility and the cavity containing cobalt and an additional ion, these are inherent properties that would be necessarily present from the presence of the same chemicals, namely the trivalent cobalt complex that has been combined with a ligand (i.e., valence stabilizer). See *In re Best*, 195 USPQ 430 and MPEP 2112.01.

Allowable Subject Matter

Claims 1, 3-53 and 123 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The above claims are allowable over the cited and applied prior art at least because as stated in the Appellant's appeal brief, filed on 9/28/2006, with respect to the Japanese patents 77 06,258, 76 42,057, 74 34,929 and 74 14,621 they do not inherently or specifically teach the use of trivalent or tetravalent cobalt complexes or the use of a valence stabilizer as defined in the instant claims. See the appeal brief, pages 4-7 for example. With respect to the instantly applied Schreiber'606 patent, cited by the applicant after the final rejection mailed on 4/4/2006, Schreiber'606 does not teach a seal applied over another coating on a metal substrate, but rather teaches only a coating or sealing layer over the substrate itself, and in fact teaches away from the use of an additional layer between the coating or seal and the metal substrate (see col. 3 lines 13-18 for example where it is stated that one of the objectives of the invention is the elimination of additional sealing layers).

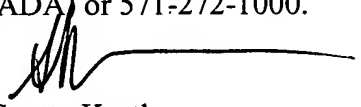
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (571) 272-1243. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Scott Kastler
Primary Examiner
Art Unit 1742

sk



ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1742